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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,431	09/13/2000	Newton James Smith JR.	AUS9000386US1	9056
35617	7590	07/09/2004		
CONLEY ROSE, P.C. P.O. BOX 684908 AUSTIN, TX 78768				
EXAMINER PHAM, TUAN				
ART UNIT		PAPER NUMBER		
2643		12		

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/662,431

Applicant(s)

SMITH ET AL.

Examiner

TUAN A PHAM

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 3-8, 10-19, and 21-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,603,839. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 3-8, 10-19, and 21-22 in the constant application have the same scope of claimed invention with obvious wording variations. Each of the above patents includes an electronic communication device such as telephone, fax machine, and PDA, which comprises a processor, storage medium, and a method for automatically updating the directory within an electronic communication device.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, and 3-8, and 10-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al. (U.S. Patent No. 6,373,940, hereinafter "Shaffer") in view of Brandon (U.S. Patent No. 5,903,632).

Regarding claim 1, Shaffer teaches an electronic communication device (see figure 1, telephone 70)(i.e., telephone) comprising:

a processor (see col.3, ln.42-45),

receiving an electronic notification of a change to a directory entry stored within the electronic communication device (see col.1, ln.50-55, col.2, ln.20-24),

presenting the electronic notification to a user of the electronic communication device (see col.2, ln.20-24).

Automatically updating the directory entry to include the altered (e.g., telephone number) upon receipt of an acceptance command generated by the user (see col.1, ln.55-65, col.4, ln.22-33). It is obvious to generate all the command when manually updating the directory by the user.

It should be noticed that Shaffer fails to clearly teach a storage medium (ROM 37) comprising program instruction executable by the processor and electronic notification is associated with an identifier, a category, and an altered value (i.e., name, telephone number, and address). However, Brandon teaches such features (see col.3, ln.35-39, col.4, ln.35-67) for a purpose of organizing the information in telephone directory.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of a storage medium (ROM 37) comprising program instruction executable by the processor and electronic notification is associated with an identifier, a category, and an altered value (i.e., name, telephone number, and address), as taught by Brandon, into view of Shaffer in order to save time and convenient for searching and updating the directory.

Regarding claim 3, Shaffer further teaches the electronic communications device wherein the altered value comprises a name, a telephone number, a mailing address or an email address (see col.3, ln.1-9).

Regarding claim 4, Shaffer further teaches the electronic communications device comprises a telephone (see figure 1, telephone 50, see col.2, ln.1-2).

Regarding claim 5, Shaffer further teaches the electronic communication device comprises a facsimile machine (see figure 2, fax 100).

Regarding claim 6, Shaffer further teaches the electronic communications device wherein the electronic communications device comprises a personal digital assistant. It is obvious to use PDA as electronic communication devices (see col.1, ln.10-15).

Regarding claim 7, Brandon further teaches the electronic communications device wherein the electronic communications device comprises: a CPU, and a storage medium comprising a data structure wherein the data structure comprises fields adapted for storage of entry content values and an entry identifier associated with each directory entry, and wherein the category heading is associated with the electronic notification corresponds to one or more headings of the fields (see figure 1, CPU 13, col.3, ln.1-39).

Regarding claim 8, Shaffer further teaches the electronic communications device wherein the entry content values comprise a name, a telephone number, a mailing address or an email address (see col.3, ln.1-9).

Regarding claim 10, Brandon further teaches the electronic communications device wherein the directory management program further comprises program instructions executable by the processor for presenting a permission prompt to the user

of the electronic communications device (see figure 2, program ROM 37, col.3, ln.35-39).

Regarding claim 11, Brandon further teaches the electronic communications device wherein the presenting comprises displaying on an output mechanism of the electronic communications device (see col.1, ln.50-67).

Regarding claim 12, Brandon further teaches the electronic communications device wherein the presenting comprises providing audible output (see col.4, ln.25-32).

Regarding claim 13, Shaffer further teaches the electronic communications device wherein the directory management program further comprises program instructions executable by the processor for receiving a confirmation indicator to accept the received electronic notification (see col.3, ln.1-24).

Regarding claim 14, Shaffer further teaches the electronic communications device wherein the directory management program further comprises program instructions executable by the processor for receiving a reject command to reject the received electronic notification (see col.3, ln.1-24).

Regarding claim 15, Shaffer further teaches the electronic communications device wherein the receiving comprises receiving a vocal input (see figure 1, telephone 50).

Regarding claim 16, Brandon further teaches the electronic communications device wherein the receiving comprises receiving a dual tone multi-frequency (DTMF) tone (i.e., manually update)(see col.2, ln.55-60).

Regarding claim 17, Shaffer further teaches the electronic communications device wherein the directory management program comprises program instructions executable by the processor for comparing the entry identifier corresponding to the directory entry with the identifier of the electronic notification (see col.3, ln.1-24).

Regarding claim 18, Shaffer further teaches the electronic communications device wherein the directory management program comprises program instructions executable by the processor for comparing the headings of the fields corresponding to the data structure of the directory with the category heading of the electronic notification upon matching the entry identifier of the directory entry with the identifier of the electronic notification (see col.3, ln.20-34).

Regarding claim 19, Brandon further teaches the electronic communications device wherein the directory management program comprises program instructions executable by the processor for replacing one or more entry content values corresponding to the directory entry with the altered value upon matching one or more headings of the fields with the category heading of the electronic notification (see col.3, ln.20-34).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In order to expedite the prosecution of this application, the applicants are also requested to consider the following references. Although Maurer et al. (U.S. Patent No. 5,048,076), Lorenz et al. (U.S. Patent No. 5,151,972), Weinstein et

al. (U.S. Patent No. 6,650,635), and Fan (U.S. Patent No. 6,636,506) are not applied into this Office Action; they are also called to Applicants attention. They may be used in future Office Action(s). These references are also concerned for supporting the system and method for providing data and voice services on the telephone line by teaching an interface device having XDSL splitter in the central office.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan A. Pham** whose telephone number is (703) 305-4987. The examiner can normally be reached on Monday through Friday, 8:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz can be reached on (703) 305-4708 and

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Information regarding the status of an application may be obtained from the

Art Unit: 2643

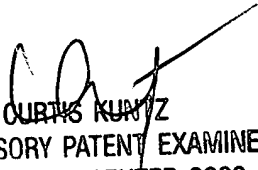
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Art Unit 2643
June 24, 2004
Examiner

Tuan Pham


CURTIS KUNTZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600